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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,313	09/01/2004	Thomas Brieden	BRIEDEN ET AL 5 PCT	8332
25889	7590	09/21/2006	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			KURTZ, BENJAMIN M	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/506,313	Applicant(s) BRIEDEN ET AL.	
	Examiner Benjamin Kurtz	Art Unit 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-15 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/04, 8/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "particularly for" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 15 recites the limitation "the tube". There is insufficient antecedent basis for this limitation in the claim. For examination purposes claim 15 has been deemed to depend from claim 13.

Claims 2-14 suffer the same defect since they depend therefrom.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-5, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Schelhas et al. US 6 672 288. Regarding claim 1, Schelhas teaches a ring filter element for a liquid filter, having an annularly positioned filter material (29), at least one end disk (30) which seals the filter material on it's end and which has a journal (40) which is positioned eccentrically in relation to the lengthwise central axis of the ring filter element and projects outward, characterized by a discharge channel (37) which penetrates the journal and the associated disk radially nest to the filter material (fig. 1).

Regarding claims 2-5, 13 and 14, Schelhas teaches the discharge channel penetrates the journal centrally and axially (fig. 1); the discharge channel (37) communicates with an inner chamber of the ring filter element encircled by filter material, which is a clean side of the ring filter element (fig. 1); the ring filter element has a central tube, an annular chamber (152) radially between the tube and the filter material (29), and the discharge channel communicates with the annular chamber (152) (fig. 1); and the end disk (30) equipped with the journal has a central opening, the tube separates a central inner chamber (14) which communicates with the central opening from the annular chamber (152) (fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 8-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schelhas (288) in view of Belgarde et al. US 2995 253. Regarding claims 8 and 9, Schelhas teaches the ring filter of claim 1 but does not teach the filter element being implemented as a secondary flow filter. Begardge teaches a ring filter element (15) having annularly positioned filter material, an end disk (19) sealing the filter material having a discharge channel radially next to the filter material, where the filter element is implemented as a secondary flow filter (fig. 1 and 2) and the secondary flow filter is connectable at an end disk (19), facing away from the discharge channel, to a ring filter element (14) implemented as a main flow filter in such a way that the secondary flow filter and main flow filter are removeable from a filter housing together (fig. 1, col. 2, lines 50-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the ring filter of Schelhas as the secondary flow filter of Belgarde because having the secondary flow filter will cause the filter to clean the oil much more effectively (col. 5, lines 22-24).

Regarding claim 11, Schelhas further teaches the discharge channel (37) is dimensioned in regard to its flow resistance in such a way that the flow through the filter is limited to a predetermined volume flow (fig. 1). The dimension of the discharge

channel of Schelhas will inherently provide restriction to a predetermined flow volume through the channel.

Regarding claims 10 and 15, Schelhas teaches the filter element of claim 1 but does not teach a further filter material. Belgarde teaches a ring filter element having filter material (15) implemented for filtering a secondary flow, the ring filter element has a further filter material (14) positioned annularly and coaxially to the lengthwise central axis of the ring filter element and axially neighboring the secondary flow filter material and is implemented for filtering a main flow, and the secondary flow filter material and main flow filter material have a shared middle disk (fig. 1). The shared middle disk comprises disks (17) and (19) which are adhesively bonded and are considered to be one disk (col. 2, lines 50-51). Belgarde also teaches the ring filter element having a tube (43) extending from an end disk (20) equipped with a discharge channel (29) up through the middle disk and the middle disk has an internal radial seal (flange (44)) supported radially on the tube to form a seal (fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the ring filter of Schelhas as the secondary flow filter of Belgarde because having the secondary flow filter will cause the filter to clean the oil much more effectively (col. 5, lines 22-24).

Regarding claim 12, Schelhas teaches the ring filter element of claim 1 but does not teach an inner frame. Belgarde teaches a ring filter element (15) having an inner frame (18) on which the filter material is supported radially (fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the

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inner frame of Belgarde because the frame strengthens the cartridge and provides an inner supporting wall for the filter element (col. 2, lines 40-51).

Allowable Subject Matter

4. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Kurtz whose telephone number is 571-272-8211. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bk 9/15/06


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